

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOEBEN BEVIRT
and
GABRIEL NOAH BRINTON

Appeal No. 2003-1639
Application No. 09/496,220

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6, 11, 13, 15 and 18 to 22. Claims 7 to 9, 12, 16, 17 and 23 to 39 have been withdrawn from consideration. Claims 10 and 14 have been canceled.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to an apparatus for transferring sample carriers and a method for presenting and retrieving sample carriers (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Garrett	4,558,984	Dec. 17, 1985
Sullivan et al. (Sullivan)	5,004,399	Apr. 2, 1991
Shiraiwa	5,203,445	Apr. 20, 1993

Claims 1, 3, 4, 11, 13, 15 and 18 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shiraiwa in view of Garrett.¹

Claims 2, 5, 6, 18, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shiraiwa in view of Garrett and Sullivan.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 26, mailed September 24, 2002) and the answer (Paper No. 29,

¹ Dependent claims 3 and 4 depend either directly or indirectly from dependent claim 2. Since claim 2 is not included in this ground of rejection it appears that claims 3 and 4 should also not be included in this ground of rejection but should have been included in the next ground of rejection which is applicable to claim 2.

mailed March 6, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 28, filed February 20, 2003) and reply brief (Paper No. 30, filed May 12, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 6, 11, 13, 15 and 18 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Claims 1 and 13, the only independent claims on appeal, read as follows:

1. A shuttle apparatus for transferring sample carriers, comprising:
a shuttle table, the shuttle table having a mating section with a void, the mating section being adapted to receive a sample carrier; and
a mating support structure having one degree of freedom adapted to travel vertically through the void in the mating section, thus transferring the sample carrier from the mating section to the mating support structure.
13. A method of retrieving and presenting a sample carrier with a shuttle apparatus comprising the steps of

presenting the sample carrier to a shuttle table of the shuttle apparatus from a mating support structure having one degree of freedom;
engaging the bottom surface of the sample carrier with the shuttle table;
moving the shuttle apparatus; and
presenting the sample carrier to the mating support structure,
wherein the presenting of the sample carrier to the shuttle table further comprises
allowing the mating support structure to pass through the shuttle table, the mating support structure passing through a void of the shuttle table to transfer the sample carrier.

The examiner's complete statement of the rejection under 35 U.S.C. § 103 (final rejection, p. 2) applicable to claims 1 and 13 is:

It would have been obvious that the articles being conveyed by the carrier 51 on shuttle 33, 34 and mating supports 25, 26, 29, 30 could be samples. It would have been further obvious that the shuttle drive could be designed for only horizontal movement if the mating supports are provided with vertical movement drive means to cause the article transfer to/from the shuttle as taught by shuttle 14 and mating supports 11 of Garrett instead of having the shuttle 33, 34 of Shiraiwa having both horizontal and vertical drives while the mating supports 25, etc. had no movement.

The appellants argue that the examiner has failed to establish a prima facie case of obviousness with respect to the claims under appeal. We agree.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The United States Patent and Trademark Office has consistently sought to follow Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) in the consideration and determination of obviousness under 35 U.S.C. 103. The four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows: (A) Determining of the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations.

Against this background, the obviousness or non-obviousness of the claimed subject matter under 35 U.S.C. § 103 must be determined. However, in this case, the examiner has not on the record either (1) determined the relevant scope and content of the applied prior art; or (2) ascertained the differences between the applied prior art (i.e., Shiraiwa) and the claims in issue. Since the examiner has not ascertained the differences between Shiraiwa and the claims in issue, the examiner can not have

determined that those differences would have been obvious at the time the invention was made to a person of ordinary skill in the art. Accordingly, we find that the examiner has not established a prima facie case of obviousness with respect to the claims under appeal.

Moreover, we see no suggestion or teaching in the teachings of Shiraiwa and Garrett for a person of ordinary skill in the art at the time the invention was made to have modified Shiraiwa in the manner proposed by the examiner in the rejection before us in this appeal. While it may be true that Shiraiwa could be so modified, the mere fact that the prior art could be modified in that manner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In our view, the only suggestion for modifying Shiraiwa in the manner proposed by the examiner stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1, 3, 4, 11, 13, 15 and 18 to 20 under 35 U.S.C. § 103 as being unpatentable over Shiraiwa in view of Garrett is reversed.

We have also reviewed the reference to Sullivan additionally applied in the rejection of claims 2, 5, 6, 18, 21 and 22 but find nothing therein which makes up for the deficiencies of Shiraiwa and Garrett discussed above. Accordingly, the decision of the examiner to reject claims 2, 5, 6, 18, 21 and 22 under 35 U.S.C. § 103 as being unpatentable over Shiraiwa in view of Garrett and Sullivan is also reversed.

REMAND

We remand this application to the examiner to ascertain the differences, if any, between Shiraiwa and claims 1 to 6, 11, 13, 15 and 18 to 22. In ascertaining the differences between Shiraiwa and the claims the examiner must interpret the claim language. Thus, for example, with respect to claim 1, the examiner must determine (1) if sample carriers are part of the claimed combination or only intended use; (2) the scope of the phrase "shuttle table" and whether or not it is readable on any one of Shiraiwa's ports 27, 28, 123;^{2, 3} and (3) if the claim language a mating support structure

² The United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of
(continued...)

having "one degree of freedom adapted to travel vertically" restricts the mating support structure to only vertical travel or only that one degree of freedom of the mating support structure is vertical travel (thus, the mating support structure may also travel horizontally). After having interpreted the claim language and then ascertaining the differences, if any, between Shiraiwa and claims 1 to 6, 11, 13, 15 and 18 to 22, the examiner should then determine if any rejection under either 35 U.S.C. §§ 102 or 103 is appropriate.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6, 11, 13, 15 and 18 to 22 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

²(...continued)
definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

³ Does the phrase "shuttle table" encompass a stationary table through or by which a shuttle or mating structure passes or does it only encompass a movable table (i.e., a table that shuttles from one position to another)?

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01.

REVERSED and REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2003-1639
Application No. 09/496,220

Page 10

GREGG A. DUFFEY
HOWREY SIMON ARNOLD & WHITE LLP
750 BERING DRIVE
HOUSTON, TX 77057-2198

JVN/jg